REMARKS

In the November 16, 2004 Office Action, the Examiner:

- Rejected claims 1-23 and 36-42 under 35 U.S.C. 101 because they are directed to non-statutory subject matter, specifically, as directed to an abstract idea; and

- Rejected claims 1-42 under 35 U.S.C. 102(b) as being anticipated by Shirley et al. (, U.S. Pat. No. 5,692,206).

Claim Rejections - 35 U.S.C. § 101

Claims 1-23 and 36-42 are rejected under 35 U.S.C. 101 because they are directed to non-statutory subject matter, specifically, as directed to an abstract idea. In particular, the Examiner states that:

> As per claims 1 and 36, the language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U. S.C. 101. As per claims 2-23 and 37-42, they contain also the same deficiency in virtue of dependency of claims 1 and 36.

All of the claims have been amended to clarify that the method is a computer implemented method. Furthermore, independent clams 1 and 36 have been amended to clarify that the first party uses a first computer system, the second party uses a second computer system and the third party used a third computer system, all of which communicate over a computer network. Support for these amendments can be found throughout the specification and figures, but in particular can be found in paragraphs 0038-0047 and Figure 1. Furthermore, it is clear from the controlling law[1] in this area that all of the pending claims are patentable, as they have practical application for organizing information and agreements.

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[1] Please note, that pursuant to MPEP § 2106 I the computer-related invention "Guidelines do not constitute substantive rule-making and hence do not have the force and effect of law." The controlling law in this area is *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999), as well as by the earlier decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368 (Fed. Cir. 1998).

In light of the above, it is respectfully submitted that the amendments to the claims address the Examiners non-statutory subject matter concerns, and, therefore, this rejection should be withdrawn.

Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1-42 under 35 U.S.C. 102(b) as being anticipated by Shirley et al. For a proper showing that these claims are anticipated by Shirley et al., all elements of each rejected claim must be disclosed in the cited reference. The rejected claims contain two independent claims, namely claims 1 and 36.

As pointed out by the Examiner "Shirley et al. disclose 'a method and apparatus for automating the generation of a legal document' by providing a contract generation system that automates the generation of various legal documents related to a negotiated agreement (See Shirley et al. Title and Abstract)." In other words, Shirley et al. disclose a method and system whereby a user using a single personal computer (Fig. 1C) can generate contracts.

Unlike Shirley et al., the present claims require at least two or three different parties using separate computer systems that communicate with one another over a computer network. Some claims also require a server computer system. In other words, the present claims require the organization of information around agreements, i.e., they facilitate, record and allow the retrieval of all of the negotiations and ancillary information related to the agreement, and do not merely generate single contract document as disclosed by Shirley et al.

Dealing with each of the Examiner's concerns in turn, the Examiner states that:

> In particular, Shirley et al. disclose the claimed limitations of "formulating a request by a first party for an agreement with a second party, the request containing an agreement ID that uniquely identifies the request and any agreement formed therefromV(See Shirley et al. col. 12, lines 32-38, Figs.7,9 and corresponding text, Fig.1 lB, components 860, 866, 872 and corresponding text).

The section of Shirley et al. relied upon by the Examiner (col. 12, lines 32-38) is repeated below for ease of reference:

> As represented by a process block 606, the user enters relevant contract data. The data entered during this step may include, for example, the names and addresses of the parties to the contract, the term of the contract, and relevant financial information. The contract generation system 100 places the entered data into the database 202 of the new contract folder 200. The data that is entered into the database 202 is used by the contract generation system 100 to fill in blanks in the basic provisions documents 204. The data may also be

used to fill in blanks in one or more of the exhibits 208 and one or ·
more of the ancillary documents 210. Additional data may also be
entered at a later stage of the contract generation process.

This cited section is consistent with the remainder of Shirley et al., which only

discloses a computer program for generating contract documents. As described in this

section of Shirley et al., a user enters data into a personal computer to help generate a

contract. However, Shirley et al. does not disclose "formulating a request by a first party

using a first client computer system for an agreement with a second party using a second

client computer system, the request containing an agreement ID that uniquely identifies the

request and any agreement formed therefrom." Indeed, Shirley et al. does not disclose, teach

or suggest a second party using a second computer, let alone the use of an agreement ID. In

fact, there is no need for an agreement ID in Shirley et al., as multiple documents that form

part of the same agreement are not being communicated between multiple parties and linked

to one another through the same agreement ID.

The Examiner further states that:

> Shirley et al. disclose the claimed limitations of "sending the request
> to the second party" (See Shirley et al. Abstract, col. 3, line 56
> through col. 4, line 24);

Although the Abstract of Shirley et al. refers to "electronic mail capabilities" there is

no mention of sending a request (an incomplete contract document) to a second party.

The Examiner further states that Shirley et al. discloses:

> "receiving correspondence from the second party regarding the
> request or any agreement formed therefrom" (See Shirley et al.(See
> Shirley et al. col. 10, lines 7-16).

Again, Shirley et al. does not disclose transmitting any agreement data between

computers, let alone receiving "correspondence over the computer network from the second

party regarding the request or any agreement formed therefrom."

Still further, the Examiner states that:

> Further, disclose the claimed limitations of "saving the
> correspondence from the second party according to the unique
> agreement ID" (See Shirley et al. col. 10, lines 16- 18 and lines 54-
> 62).

Again, Shirley et al. cannot disclose saving correspondence from a second party, as

Shirley et al. does not disclose receiving anything from a second party, and, therefore, cannot

save any correspondence from such a second party. Shirley et al. also does not disclose

connecting any requests and correspondence to the same Agreement ID.

Regarding independent claim 36 the Examiner states:

> As per claim 36, the claim has substantially the same limitations as claim 1. These limitations have already been discussed in the rejection of claim 1.

For the reasons stated above, independent claim 36 cannot be anticipated by Shirley et al., as claim 36 contains many of the same limitations as claim 1. In addition, independent claim 36 includes many additional limitations to independent claim 1. For example, claim 36 requires a first request from a first party and an acceptance from a second party to form a first agreement, and a second request from the second party and an acceptance from a third party to form a second agreement. Shirley et al. only discloses generating contractual paperwork and does not disclose requests and acceptances between multiple different parties, let alone two different agreements between three different parties.

The Examiner further states that:

> In addition, Shirley et al. further disclose the claimed limitations of "linking the second agreement to the first agreement by including the first agreement ID" by providing a site number or information to identify the contract (See Shirley et al. col. 10, lines 19-28 and col. 2, lines 32-38) . . .

After a careful review of the cited sections of Shirley et al., applicants could find no mention of two agreements, let alone linking two agreements to one another using a first agreement ID.

The Examiner further states that Shirley et al. also discloses

> the claimed limitations of "in the field identifying a downstream agreement to form a supply chain among the first, second and third parties" (See Shirley et al. col. 7, lines 22-40, and Fig 7 col. 8, lines 18-48).

Again, Shirley et al. does not disclose, teach or suggest any agreements formed (not merely a generated contract document) between three parties. Furthermore, Shirley et al. does not disclose identifying a supply chain as required by this element of claim 36.

In light of the above, it is respectfully submitted that Shirley et al. does not disclose, teach or suggest all of the limitations of each of the independent claims 1 and 36. Furthermore, Shirley et al. cannot anticipate any of the claims that depend from independent claims 1 and 36. Therefore, it is respectfully submitted that in light of the amendments and the arguments presented above it is now clear that all pending claims cannot be anticipated by Shirley et al.
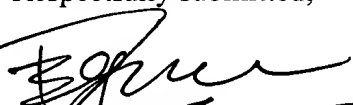
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at 650-843-4000 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 063898-5001-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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